

## REMARKS

Reconsideration of this reissue application is requested.

A Petition/Declaration to Withdraw Holding of Abandonment Based Upon Failure to Receive Office Action is being filed simultaneously herewith to withdraw the April 22, 2003, Holding of Abandonment of the above-referenced patent application.

Applicants will surrender U.S. Patent No. 5,873,073 upon receiving a notice of allowability of the subject application.

The Examiner has objected to the December 20, 2001, Amendment under 35 USC §132, because it introduces new matter into the disclosure. The Examiner is of the opinion that the disclosure as originally filed does not provide support for using permit mail. In the summary of the invention at page 2, lines 39-43, Applicants stated:

“Once the document has been printed, the document is inserted into the envelope by inserting means to form an unfinished mail piece. The unfinished mail piece is sealed and then franked with appropriate postage in order to form a finished mail piece.”

On page 4, lines 7-17, the issued patent states:

“At step 118, the printed document is merged with the printed envelope to create an unfinished mail piece. From step 118, the method advances to step 120 where the unfinished mail piece is franked with appropriate postage by a postage meter and then placed into the mail stream at step 122”.

The addition of the expression “if it is not permit mail or mail having a postage stamp” after the word “franked” in the above two paragraphs is not new matter. One skilled in the postage art knows that the USPS requires postage to be applied to a finished mail piece that will be accepted by the USPS. Postage may be paid by affixing

a stamp to the mail piece, affixing a postal indicia to the mail piece with an approved postage meter, or by permit mail.

The United States Postal Service "Glossary of Postal Terms", Publication No. 32, Pub. May 1997, defines the terms "permit" and "permit imprint" on page 83 as follows:

**"permit** - Any authorization required for specific types of preparation or postage payment. Specifically, an authorization to mail without postage affixed by using indicia or an imprint. Payment is made against an advance deposit account that is established with the USPS for postage and services.

**permit imprint** - Printed indicia, instead of an adhesive postage stamp or meter stamp that shows postage prepayment by an authorized mailer. (Also see *permit*)."

This Amendment adds the expression "or mail having a postage stamp" so that the new added expression in the above paragraph reads "...if it is not permit mail or mail having a postage stamp" to the paragraph mentioned on page 2 and page 4. Applicants are just clarifying the application by listing ways to pay for postage, which is well known to those having ordinary skill in the art.

See *Chisum On Patents* Vol. 4 §11.04[2][a] which reads as follows:

**[a] - Clarifications.** Court decisions state, in various ways, that specifications may be amended to "clarify" the original disclosure; thus: (1) "insertions by way of amendment in the description or drawing, or both, of a patent application do not invalidate the patent, if they are only in amplification and explanation of what was already reasonably indicated to be within the invention"; (2) "amendments may be made to patent applications for the purpose of curing defects, obvious to one skilled in the art, in the drawings or written descriptions of inventions"; (3) "an amendment to an application is not 'new matter' within the Patent Act or Rules of the Patent Office unless it discloses 'an invention, process or apparatus not theretofore described.'... If the later-submitted material accused of being 'new matter' simply clarifies or completes the prior disclosure it cannot be treated as 'new matter.'... Moreover the determination of the Patent Office to admit the later-submitted

material accused of being 'new matter' simply clarifies or completes the prior disclosure it cannot be treated as 'new matter.'... Moreover, the determination of the Patent Office to admit the later-submitted material, thereby signifying that the Patent Office does not consider it to be 'new matter,' is presumptively correct.", (4) "the amendments to the specification merely render explicit what had been implicitly disclosed originally, and, while new language has certainly been added, we are not prone to view all new 'language' ipso facto as 'new matter.'"..."

The Examiner has objected to the specification and claim 51 under 35 USC §112 as not providing support for the invention as now claimed. The Examiner is of the opinion that the use of permit mail is new matter. For the reasons mentioned above, the use of permit mail is not new matter.

Claims 20, 24, 28-39 and 43-47 have been rejected by the Examiner under 35 USC §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner is of the opinion that claims 20, 24, 28-39 and 44-47 fail to recite that the item of mail is franked and, hence, is not a finished mail piece as the instant invention is intended to produce.

In claim 20 as amended and those claims dependent thereon, Applicants are claiming a method for producing a mail piece. Applicants have amended claim 20 to include the step of "providing said printed envelope with evidence of postage payment". The mailer may pay the postage for mailing the mail piece by affixing a stamp to the mail piece, affixing a permit imprint to the mail piece, or franking the mail piece with an approved postage meter. Thus, claim 20 and those claims dependent thereon are not indefinite. In new claim 52 which depends on claim 21, the evidence of postage is a postal indicia; and in claim 51, as amended, the evidence of postage is a permit mail postal indicia.

In the Examiner's opinion, claims 20, 24, 28-39 and 44-47 are inoperative and lack utility for the recited purpose of the disclosed and claimed invention, because the recited purpose of the invention is to produce a finished mail piece that has been properly franked. Applicants disagree with the Examiner. The recited and stated purpose of the disclosed invention is to produce a finished mail piece as indicated in column 2, lines 17-19 of the patent being requested to be reissued which read as follows:

"According to the invention, the object is achieved and the disadvantages of the prior art are overcome by a method for producing a finished mailpiece."

It is well known that a properly addressed mail piece containing the correct postage is a finished mail piece. The correct postage may be placed on the mail piece by applying a stamp; applying a postal indicia; or by affixing a permit indicia, etc. Thus, claims 20, 24, 28-39 and 44-47 do not lack utility since they claim a finished mail piece.

Claims 1-4, 6, 7, 11, 12, 15, 22, 24-26, 29-36, 38-41, 43-46, and 48-50 have been rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Baker, et al. (U.S. Patent No. 5,067,305), Murcko, et al. (U.S. Patent No. 5,476,255) or Cordery, et al. (U.S. Patent No. 5,628,249) in view of Humes, et al. (U.S. Patent No. 5,377,120).

Cordery discloses the following in column 1, line 64 to column 2, line 14:

"...an apparatus and method for producing a mail piece, wherein the apparatus includes a first printer for printing a document and a mail finishing unit for receiving the document from the first printer and inserting the document into an envelope to form a mail piece. The mail finishing unit includes a second printer for printing an address on the envelope prior to insertion of the document into the envelope. The apparatus also includes a controller which is responsive to mail piece data; the mail piece data including first data

for defining the document and second data for defining the address to be printed on the document. In accordance with the method of the subject invention the document is printed in the first printer and the envelope is printed with the corresponding address in the second printer prior to insertion of the document into the envelope and the printed document and printed envelope are fed along separate paths to an inserter where the document is inserted into the envelope. "

Harman discloses the following in column 1, line 66 to column 2, line 14:

"...a system including a plurality of apparatus for producing a mail piece, wherein the apparatus each include a first printer for printing a document and a mail finishing unit for receiving the document from the first printer and combining the document with an envelope to form a mail piece. The mail finishing unit includes a mechanism for franking the mail piece. The apparatus also includes a controller which is responsive to mail piece data; the mail piece data including first data for defining the document and second data for defining the address to be printed on the document and postal data defining a postage value for the mail piece. The controller controls the first printer to print documents in accordance with the document data and controls the franking mechanism to frank the mail piece with the postage value."

Baker discloses the following in column 3, lines 1-16:

"...an apparatus which includes an input for input of information defining a mail piece configuration and sheet processing apparatus for accumulating sheets with an envelope form, folding the accumulated sheets and envelope form, and then sealing the envelope form to form the mail piece; where the folder sealer apparatus has a capacity to fold a predetermined maximum number of sheets. The apparatus of the subject invention also includes a control system for determining the number of sheets in the mail piece in accordance with the defining information and, if the number of sheets is less than the maximum, controlling the folder sealer apparatus in accordance with the defining information to form the mail piece in the configuration, and, if the number of sheets is greater than the maximum, aborting operation of the folder sealer apparatus without forming the mail piece."

Murcko discloses the following in column 3, lines 7-13

"...a means of a mechanism for feeding sheets from a stack which include a low force feed device for urging the top sheet of the stack forward, and a combined device for receiving the top sheet,

corrugating the top sheet, singulating the top sheet from a following sheet which may have adhered to the top sheet and feeding the top sheet forward for further processing."

Humes discloses the following in column 2, lines 39-61:

"...a machine for lowering the mailing costs of small volume merchants by producing bundles for low postal rate mailings which are made up of the commingled pieces from a plurality of merchants. The machine comprises, in the preferred embodiment, a first computer operable to combine the mailing lists of a plurality of merchants and group the addresses on the mailing lists according to the lowers postal rate. The first computer is further operable to generate the address information required by postal regulations, such as bar codes or zip+4 numbers, for each address; and to further assign a merchant-identifier tag to each address thus creating a merged data base of the merchants' mailing lists. The first computer is further operable to generate documentation for the post office as well as individual client invoices. A second computer serves as a sequence controller to operate mail piece handling machinery according to the grouped addresses. The present invention further comprises the mail piece handling machinery for physical commingling and addressing of the different merchants non-alike pieces."

Humes discloses the following in his Abstract:

"...The apparatus can take pre-printed, unaddressed mail pieces of non identical size delivered to the mailing service from different merchants and combine the mail pieces to create mailing bundles at the lowest postal rate and group the bundles to create a single mailing."

Thus, Humes is a presort house that does not disclose a second printer that prints documents in accordance with characteristics selected at a first node.

The art cited by the Examiner does not disclose or anticipate, separately or together, the method and system of defining and producing the finished mail piece claimed by Applicants. Applicants claim a method and system that allow a user to select at a first node a plurality of characteristics that define a mailing. Once the selections have been made, the selected information is transmitted to a terminal node,

wherein the terminal node is not co-located with or under the control of the first node so that the terminal node may control the time of production of mail pieces. The terminal node may also direct the production of mail pieces to mail production means for producing the mail, wherein a second printer at the terminal node prints the document in accordance with the characteristics selected at the first node, and the printed document is inserted into an envelope to form an unfinished envelope which is subsequently franked.. Hence, the mail piece may be directed to specific mail production means so that mail pieces may be produced efficiently or produced at a site that is closer to the recipient of the mail piece. Thus, the mail piece may be delivered in less time since it may be electronically transmitted to a site where it is produced and subsequently mailed from a site that is closer to the recipient.

The art cited by the Examiner for claim 1 and those claims dependent thereon, does not disclose or anticipate steps d, e, and g of claim 1, namely,

- (d) transmitting electronically said print job to a terminal node wherein said terminal node is not co-located with, nor under the control of, said first node;
- (e) receiving said print job at said terminal node, said terminal node for receiving said print job and for directing said print job to a mail production means for producing said mail piece, said mail production means further comprising:
  - (i) a first printer; and
  - (ii) a second printer;
- (g) printing on said second printer, said document is printed in accordance with characteristics selected at said first node.

Cordery, Harman, Baker, Murcko, or Humes, taken separately or together, do not disclose or anticipate claim 15 and those claims dependent thereon. The above references do not allow one to control the time for producing a mail piece consisting of a document and an envelope that utilize transmitting means to transmit a mailing to second data processing means that are not co-located with or under the control of first data processing means. Furthermore, the document is printed at a second printer located at the second data processing means whereby the document is subsequently inserted into an envelope which is then sealed and franked to reduce the time for delivering the mail piece to a recipient. Thus, elements b, c, and e are not disclosed or anticipated by the above references, namely:

- (b) transmission means for transmitting said mailing to a second data processing means wherein said second data processing means is not co-located with, nor under the control of, said first data processing means;
- (c) second data processing means for receiving said mailing and downloading said mailing to a plurality of printer means comprising a first printer and a second printer;
- (e) second printer means comprising said second printer for printing said document to media selected at said first data processing means.

Cordery, Harman, Baker, Murcko and Humes, taken separately or together, do not disclose or anticipate claim 20, as amended, and those claims dependent thereon. The above references do not define and produce a mailing by transmitting an electronic document, characteristics of a mailing produced at a first node, and an address list to a terminal node wherein the terminal node is not co-located with or under the control of



the first node so that a document is printed in accordance with the characteristics selected at the first node. Then the document is inserted into a corresponding printed envelope and provided with evidence of postage payment.

The art cited by the Examiner for claim 20 as amended and those claims dependent thereon does not disclose or anticipate the following steps of claim 20 as amended, namely

- creating a document and storing said document in electronic form;
- transmitting said document, said address list and said characteristics to a terminal node wherein said terminal node is not co-located with, nor under the control of, said first node;
- printing said document in accordance with one or more of said characteristics selected at said first node; and
- providing said printed envelope with evidence of postage payment.

Cordery, Harman, Baker or Humes, taken separately or together, do not disclose or anticipate claim 38, as amended. The above references do not disclose a system for producing a mail piece that has second data processing means that is not co-located or under the control of a first data processing means which electronically receive selected documents and direct the selected documents to a mail production means that includes printing means that print the selected document, an envelope for the selected document and means for printing the envelope with evidence of postage payment.

The Examiner stated in the last paragraph of page 7 of the September 20, 2002, Patent Office Action that "Further in regard to claims 1, 21, 22, 25, 26, 40, & 41 it is

noted that neither Baker et al ('305) nor Murcko et al ('255) nor Cordery et al ('249) nor Harmon [sic] et al ('706) actually depict a postage meter. However, each of Baker et al ('305) or Murcko et al ('255) or Cordery et al ('249) or Harmon [sic] et al ('706) disclose that after the completed mail piece has been generated, the mail piece is franked and placed in the postal system for delivery." While the above is true, the cited patents do not disclose or anticipate franking at a terminal node that is not co-located or under the control of the first node.

Regarding claims 8-10, the nodes of the cited patents are located at the same location whereas the terminal node of independent claim 1 is not co-located nor under the control of the first node. The foregoing allows someone to electronically send information to a terminal node where mail pieces are physically produced closer to the recipient so that postal delivery time will be reduced enabling the recipient to receive his/her mail earlier.

Regarding claim 28 which depends on claim 20, the terminal node is not co-located with or under the control of the first node.

Claims 5, 37 and 47 have been rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over either Cordery, et al. (U.S. Patent No. 5,628,249) or Harman, et al. (U.S. Patent No. 5,684,706) or Baker, et al. (U.S. Patent No. 5,067,305) or Murcko, et al. (U.S. Patent No. 5,476,255) as modified by Humes, et al. (5,377,120) and further in view of common practice.

Claim 5 is dependent on claim 1, and claims 37 and 47 include all of the limitations of claim 20. As previously mentioned, the cited art does not include the limitations of independent claims 1 and 20. Furthermore, the cited art does not disclose

or anticipate a receipt that is indicative of a print job that is generated by a terminal node and transmitted to a first node as claimed in claim 5. The cited art does not disclose or anticipate the manner in which claim 37 utilizes a terminal node to provide an indication to a first node that mail has been placed into the mail stream for delivery.

The cited art also does not disclose or anticipate a second data processing means that provides an indication to the first data processing means that mail has been placed in a mail stream for delivery.

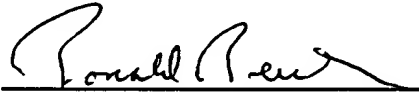
Claims 13 and 14 have been rejected by the Examiner under 35 USC §103(a) as being unpatentable over Harman, et al. as modified by Humes, et al. and in view of common practice.

The cited art or general practice does not disclose a second node that makes the distribution based upon the availability of the second node as claimed in claim 13. The supplies available are not the only factor that has to be determined by the second node to make the distribution. The availability of the equipment to generate the mail piece must also be considered.

The cited art or general practice does not disclose or anticipate a distribution that is determined by the location of the terminal node as claimed in claim 14. This allows mail pieces to be produced at a site that is located closer to the recipient of the mail piece. Thus, the mail piece may be delivered in less time since it may be produced at a site and subsequently mailed from a site that is closer to the recipient. This is especially important to posts in the developing world where it takes a great deal of time to deliver mail between two regions of the country.

New claim 53 has been added. Claim 53 reads the same as claim 1 of the original patent which is being reissued. In view of the foregoing amendments and Remarks, it is respectfully submitted that claims 1-53 of this Application are now in condition for allowance, and favorable action thereon is requested. Will the Examiner please call the attorney noted below to schedule a telephone conference to discuss this Application.

Respectfully submitted,



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